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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,071	04/18/2001	Brian Mark Shuster	KM0345.014A	8828
20995 7590 06/04/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
06/04/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

09/837,071

**Applicant(s)**

SHUSTER, BRIAN MARK

**Examiner**

Donald L. Champagne

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-22, 24, 25 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-22, 24, 25 and 27-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Interpretations of Claim Language*

1. Note on interpretation of claim terms - Unless a term is given an "explicit" and "clear" definition in the specification (MPEP § 2106.II.C), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skilled in the art (MPEP § 2111). This means that the words of a claim must be given their "plain meaning" unless the plain meaning is inconsistent with the specification (MPEP § 2111.01.I and 2111.01.III). An explicit and clear definition must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example. An applicant may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning (MPEP § 2111.01.IV and 2173.05(a)).
2. **Reception device** – A device communicating with an **aggregated information system** that can receive message data contained on the plurality of **remote information systems**. See the abstract, and para. [0021] and [0022] in the published application (US 20010056371A1).
3. **Aggregated information system (AIS)** – The applicant's special name for an electronic network device used in the invention (Fig. 2 and para. [0023] of the published application).
4. **Aggregating application** – One or more pieces of software that act together to aggregate (gather) information from **remote information systems**.
5. **Remote information system** – An electronic network device operating a "bulletin board" (claims 3 and 22, Fig. 2 and para. [0023] of the published application).

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3, 5, 6 and 8-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "an information system comprising computer hardware" (claim 1, line 2) is new matter. The specification discloses three kinds of "information systems"<sup>1</sup>, but nothing merely called "an information system". Furthermore, the specification does not disclose that any of these three kinds of information systems are "computer hardware". This rejection can be overcome by amending "an information system comprising computer hardware, the information system" (claim 1, line 2) to – an electronic network device –, which is supported at para. [0023] of the published application and Fig. 2.
8. Claims 1-3, 5, 6, 8-22, 24, 25 and 27-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A - In each claims 12 and 21, "a different reception device" is new matter.

B – Respectively in claims 1 and 21, "wherein the aggregated information system/one or more computer processors is separate from the plurality of remote information systems and the plurality of reception devices" is new matter. A figure (e.g., Fig. 2) with separate boxes is not sufficient support. The spec. (para. [0023] of the published application) discloses only that both the AIS and the RIS comprise "a memory device" and a server. There is no disclosure that the AIS and RIS are "separate". As for claim 21, there is no disclosure at all of a "computer processor".

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<sup>1</sup> The spec. discloses: an "aggregated information system" (para. 3 herein); a "remote information system" (para. 5 herein); and an "on-line information system" (para. [0004]-[0007] of the published application).

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9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-3, 5, 6, 8-22, 24, 25 and 27-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A - At two places in each claim 1 and 21, "wherein the original/response message data relates to a previously posted new/response message" is indefinite. How does it "relate"? This rejection can be overcome by amending "relates to" to -- is --, which is supported at para. [0024] of the published application.

B - At two places in each claim 1 and 21, "a different reception device" is indefinite. "Different" from what?

#### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 21, 22, 24, 25 and 27-36 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, \_F.3d\_, 2008 WL4757.
13. The instant claims fail to meet the machine-or transformation test because the claimed aggregation method, which reads on an algorithm, is so broad as to pre-empt all uses of a

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fundamental principle in the one field of information retrieval. The CAFC ruled in *Bilski*, "Pre-emption of all uses of a fundamental principle in all fields and pre-emption of all uses of the principle in only one field both indicate that the claim is not limited to a particular application of the principle. See *Diehr*, 450 U.S. at 193 n.14 ('A mathematical formula in the abstract is nonstatutory subject matter regardless of whether the patent is intended to cover all uses of the formula or only limited uses.') (emphasis added)."

14. Claims 1-3, 5, 6 and 8-20 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Although the claims on their face are directed to the "machine" or "manufacture" category of patent-eligible subject matter in Section 101, the claims are nonetheless nonstatutory based on the following two-part inquiry to determine whether the scope of the claimed invention encompasses one of the judicially-created exceptions:

For a claimed machine (or article of manufacture) involving a mathematical algorithm, the claimed "aggregation application" reading on a mathematical algorithm,

(1) Is the claim limited to a tangible practical application, in which the mathematical algorithm is applied, that results in a real-world use (e.g., "not a mere field-of-use label having no significance")?

(2) Is the claim limited so as to not encompass substantially all practical applications of the mathematical algorithm either "in all fields" of use of the algorithm or even in "only one field?"

If the machine (or article of manufacture) claim fails either prong of the two-part inquiry, then the claim is not directed to patent eligible subject matter. (*Ex Parte Gutta*, BPAI 2009, Precedential)

In this case the claims encompass substantially all practical applications of the aggregation application mathematical algorithm in the one field of information retrieval.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-3, 5, 6, 8-22, 24, 25 and 27-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over Herz et al.

(US005754938A, hereafter "Herz").

18. Herz teaches (independent claims 1 and 21) a system and method for aggregating information, the system comprising:

an information system comprising computer hardware (*electronic media system*, col. 28 lines 44-52 and Fig. 1), the information system comprising an aggregating application (*Virtual Community Service*, col. 73 lines 36-41) in communication with a plurality of remote information systems (*thousands of Internet bulletin boards*, col. 73 lines 11-17), that are configured to communicate with a plurality of reception devices (*personal computers (terminals)  $T_1$ - $T_m$* , col. 28 lines 52-56, and *clients  $C_1$ - $C_m$* , col. 30 lines 26-31), said aggregating application executing in one or more computer processors (*servers  $S1$  to  $S5$* , col. 30 lines 26-31) and configured to:

*creating a new virtual community  $V$*  (col. 76 lines 7-10), which reads on aggregate original message data and response message data from different ones of said plurality of remote information systems to create aggregated message and response data relating to a topic (*common interests of groups of users*, col. 74 lines 42-43), wherein the original message data relates to a previously posted new message (*messages addressed to the user*, col. 9 lines 36-38) and wherein the response message data (*replies*, col. 12 lines 16-21 and col. 17 lines 45-47, and *updated target object*, col. 63 lines 43-46, and *monitor document activity*, Fig. 5 item 506, and *quoted material from previous messages*, col. 74 lines 36-38 ) relates to a previously posted response message to the previously posted new message;

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provide said aggregated message and response data to all users having a *high interest* in receiving said message data (col. 76 line 66 to col. 77 line 4) at a plurality of reception devices (clients  $C_1$ - $C_n$ , col. 30 lines 26-31), which reads on providing to a different reception device that is configured to post message data to the aggregated information system (*electronic media system*, col. 28 lines 44-52 and Fig. 1);

receive at the aggregating application, additional message data (new messages, col. 76 lines 62-65) from all users having a *high interest* in receiving said message data (col. 76 line 66 to col. 77 line 4) at a plurality of reception devices (clients  $C_1$ - $C_n$ , col. 30 lines 26-31), which reads on providing to said different reception device, wherein said additional message data from said "different" reception device comprises additional response message data (*replies*, col. 12 lines 16-21 and col. 17 lines 45-47, and *updated target object*, col. 63 lines 43-46, and *monitor document activity*, Fig. 5 item 506, and *quoted material from previous messages*, col. 74 lines 36-38 ), the additional response message data relating to response message responding to the previously posted new message and the additional original message data relating to a new message;

aggregate said additional message data with said aggregated message and response message data (col. 76 lines 62-65); and

determine whether at least one of said remote information systems contains information relating to a topic of said additional message data (new messages whose target profiles are similar to the community's cluster profile, col. 76 lines 62-65) and

provide the additional message data to the at least one of said remote information systems based on the determination that said at least one of said plurality of remote information systems contains information relating to a topic of said additional message data (col. 76 line 66 to col. 77 line 4),

wherein the aggregated information system (*electronic media system*, col. 28 lines 44-52 and Fig. 1, in any of the *servers*  $S_1$  to  $S_5$ , col. 30 lines 54-60) is separate from the plurality of remote information systems (*thousands of Internet bulletin boards*, col. 73 lines 11-17, running on *servers*  $S_1$ - $S_5$ , col. 30 lines 26-31) and the plurality of reception devices (*personal computers (terminals)*  $T_1$ - $T_n$ , col. 28 lines 52-56, and *clients*  $C_1$ - $C_n$ , col. 30 lines 26-31) and the plurality of reception devices is separate from the different



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reception device (inherently, because anyone of the *clients*  $C_1-C_n$  can be "separate" from the remaining plurality).

19. Alternatively, the claimed distinction between "original" and "response" message data is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A). Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.
20. Alternatively, because the aggregation would be worthless without both original and response message data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Herz that both original and response message data be aggregated.
21. Herz also teaches at the citations given above claims 3 and 22, claims 5, 6, 24 and 25, and claims 17, 18, 32, and 33.
22. Herz also teaches: claim 2 (col. 56 lines 28-30 and Fig. 2); claims 16 and 31 (col. 73 lines 29-32); claims 19, 20, 34 and 35 (col. 17 lines 15-33); and 36 (col. 18 lines 13-23 and col. 55 lines 38-60).
23. Claims 8-15 and 27-30 add only non-functional descriptive material (printed matter) and, accordingly, were not given patentable weight (MPEP § 2106.01 and 706.03(a)A and page 8-9 of the Board decision mailed 3 September 2009). .

### ***Response to Arguments***

24. Applicant's arguments filed with an amendment on 19 April 2010 have been fully considered but they are not persuasive. Most of the arguments have been addressed in the revised rejection. One argument requires special reply.
25. Applicant argues (pp. 13-14) that the examiner said the rejection under 35 USC 101 (para. 111-15 above) could be overcome by the present amendment: "Specifically, Examiner Champagne stated that the present claims need to be amended to define what 'original message data' and 'response message data' were so that substantially all practical applications are not pre-empted." This is not what the examiner said, and the interview summaries made of record by both the applicant (p. 10 of the filing on 19 April 2010) and the examiner (mailed 25 March 2010) do not support this allegation. The examiner's position

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was and is as stated by the CAFC (para. 13 above): The claims are not statutory because they pre-empt all uses of a principle.

#### ***Search for Allowable Matter***

26. The examiner has searched this application for potentially allowable matter (i.e., a feature of the disclosed invention that would overcome the rejection of record) and regrets to report that none was found. If applicant believes any one or more features are potentially patentable, it would behoove the applicant to clearly identify those features by an after-final filing under 37 CFR 1.116.

#### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
30. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782.
31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

32. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. **The examiner will grant an interview after final only when applicant files an interview request (form PTOL-413A)** containing compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration..
33. Applicant may have after final arguments considered and amendments entered by filing an RCE.
34. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

1 June 2010

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688